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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,028	12/23/2005	Eckhardt Lubke	ZAHFRI P802US	5557
20210 7590 04/24/2009 DAVIS & BUJOLD, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301				
EXAMINER				
PILKINGTON, JAMES				
ART UNIT		PAPER NUMBER		
3656				
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04/24/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/562,028

Applicant(s)

LUBKE ET AL.

Examiner

JAMES PILKINGTON

Art Unit

3656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 6-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 March 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the structural detail including the connection between components and arrangement of the structure in the device as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). It currently appears that drawing is showing a schematic of the device in various operation arrangements and not the structure and the structural relations being claimed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The amendment filed 3/09/09 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- The rotational axle being perpendicular to the groove (amendment made on page 4 line 2 of marked up specification), the specification only contained support for a parallel arrangement as disclosed in the specification since the drawings do not show any detail of the device.
- New Figure 2 is objected for disclosing new matter. Upon the original filing there was no support for this arrangement with what appears to be shift finger F attached to the rotating barrel. In addition, Figure 2 still does not disclose the structural arrangement being claimed as noted in the prior office action and above.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for all the structure being claimed, does not reasonably provide enablement for the relationship/connection between the structure in the device. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. For example the specification, drawings or claims do not disclose the following: How is the selection finger arranged relative to the grooves so that it engages the grooves? What are the wedge-shaped tips, are these part of the grooves? How is the compression spring arranged relative to the device to exert a force on the wedge-shaped tips? How is the neutral groove bound to each gear stage?

In the Applicants Remarks filed 3/9/09 there is a discussion of how the device works and references the schematic shown in Figure 1. However, a schematic representation does not enable one of ordinary skill to make and/or use the device. The schematic does not show the structural relation between the elements. One of ordinary skill in the art could not make or use the device based on the schematic representation provided by the Applicant. For example, how are the rocker elements attached on individual rotatable axles and where are these axles in relation to the rest of the device? How are the springs attached to the rocker elements?

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 6-14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bart, DE19543645 (cited by Applicant).

Bart disclose a shift device for a transmission with a cam drive comprising a shifting roll (10) rotatably guided on an axle (11) and having grooves (7, 8, 9, 16) in an exterior surface, a selection finger (4, 5, 6, 17) which engages the grooves, a plurality of rocking elements (edges of grooves) rotatable supported by the axle, wherein the rocker elements are located proximate an outer circumference of the shift roll and each rocker elements is provided on each respective end thereof with a wedge shape (slopes of grooves) tip and a compressions spring (15) placed on one side of the rotatable axle to exert a force on the wedge-shaped tips (exerts force by biasing fingers against a wall of the grooves), wherein a neutral groove is bound to each groove, wherein each groove comprises a plurality of neutral groove portions and at least one gear stage groove portion (neutral is between different gear stages within the shift assembly) and a pair of neutral groove portions are located on each side of the at least one gear stage groove portion.

7. Claims 6-8, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Bigi, US PGPub 2003/0213319.

Bigi disclose a shift device for a transmission with a cam drive, which has a shifting roll (29, See Figure 8) rotatably guided on an axle (17) and having grooves (30), a selection finger (13) which engages the grooves (30), rocking elements (edges of grooves) rotatable supported by the axle (17) wherein the rocker elements are located proximate an outer circumference of the shift roll and each rocker elements is provided on each respective end thereof with a wedge shapes (slopes of grooves) and a compressions spring (35) placed on one side of the rotatable axle to exert a force on the wedge-shaped tips (exerts force by biasing fingers against a wall of the grooves 30), wherein a neutral groove is bound to each groove, wherein each groove comprises a plurality of neutral groove portions and at least one gear stage groove portion (neutral is between different gear stages within the shift assembly) and a pair of neutral groove portions are located on each side of the at least one gear stage groove portion.

NOTE: Claims 9, 12 and 14 contain functional language which only describes how the device is intended to operate. The way device functions does not structurally differentiate the device over the prior art, see MPEP 2114.

Response to Arguments

8. Applicant's arguments filed 3/9/09 have been fully considered but they are not persuasive.

9. Regarding the Applicant's remarks with respect to 35 USC 112 1st paragraph see the remarks above.

10. The Applicant argues that Bart does not disclose the claimed "pivotable rocker elements."

As best understood, Bart does indeed disclose pivotable rocker elements as discussed above. The instant application does not disclose in any detail what a "pivotable rocker element" is. In fact a "pivotable rocker element" as shown in Figure 1 appears to be a line or a part of the groove, this Bart does indeed disclose.

11. With regards to the arguments directed toward Bigi the Applicant is arguing limitations not found in claims 6-8 in which Bigi is being used to reject. The feature of the spring being claimed is found in new independent claims 9 and 14 of which Bigi is not being used to reject.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES PILKINGTON whose telephone number is (571)272-5052. The examiner can normally be reached on Monday - Friday 7-3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571)272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES PILKINGTON/
Examiner, Art Unit 3656
4/17/09

/Richard WL Ridley/

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Supervisory Patent Examiner, Art Unit 3656